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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,298	08/01/2001	Philipp W. Kutter	22358-04989	5647

758 7590 06/17/2005

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EXAMINER

FOWLKES, ANDRE R

ART UNIT PAPER NUMBER

2192

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,298

Applicant(s)

KUTTER, PHILIPP W.

Examiner

Andre R. Fowlkes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is in response to the amendment filed 3/18/05.

***Claim Rejections - 35 USC § 112***

2. The rejection to claims 1-10 is rejected under 35 U.S.C. 112, second paragraph, is withdrawn, in view of applicant's amendment.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 does not clearly define the element or describe the algorithm and actions performed by the code in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

5. The rejection to claims 1-10 under 35 U.S.C. 101 is withdrawn, in view of applicant's amendment.

***Drawings***

6. The objection to the drawings is withdrawn, in view of applicant's amendment.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by De Boor et al. (De Boor) U.S. Patent No. 6,173,316.

As per claim 1, De Boor discloses a **method for the direct execution of an XML-document in a data processing system**, (col. 3:58-67, “providing a wireless communication device with an MMI (i.e. browser) that is based on a markup language (i.e. XML). A markup language is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content,

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instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content”, and col. 9:45-51, “The present invention is not limited to HTML, but also operates with, and may extend any other markup language, such as SGML, or XML”), **comprising:**

- **defining the local behavior and process for each element of the XML-document** (col. 3:59-66, “A markup language (i.e. XML) is a computer programming language that allows the content of a page or a screen display (i.e. local behavior and process) to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen”),

- **integrating executable instructions with at least one XML-document or a document type definition (DTD)** (col. 3:58-60, “providing a wireless communication device with an MMI (i.e. browser) that is based on a markup language (i.e. XML).”, and this process is essentially the integration of the executable instructions with the XML document),

- **storing intermediate states of the execution process in a memory of the data processing system by dynamically creating and redefining attributes of elements of the XML document** (col. 62:9-10, “(intermediate states of the process are stored and) replacing the tag with the second markup language page to form a combined markup language page (i.e. the elements are redefined)”).

As per claim 2, the rejection of claim 1 is incorporated, and further De Boor discloses that:

**- integrating executable instructions by defining for each XML-element definition and its instances an action made up of executable actions, and actions which are references to either the action defined for one of the components of the element or to an action defined for any other element of the XML document** (col.

3:58-67, "providing a wireless communication device with an MMI that is based on a markup language (i.e. executable instructions integrated with XML documents). A markup language is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content"),

**- executing an XML-document by executing the action defined for the root of the XML document** (col. 3:59-66, "A markup language (i.e. xml document) is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content").

As per claim 3, the rejection of claim 1 is incorporated, and further De Boor discloses that **defining a composition of the action for at least one XML-element definition or instance by graphical flow charts** (col. 7:36-38, "a flowchart of the operation of the HTMLp content handler in processing a string input associated with a user interface gadget", and col. 9:49-51, "The present invention is not limited to HTML, but also operates with, and may extend any other markup language, such as SGML, or XML").

As per claim 4, the rejection of claim 1 is incorporated, and further De Boor discloses **defining the composition of the action for at least one XML-element definition or instance in textual form** (col. 3:59-66, "A markup language (i.e. xml document) is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instruction for the layout of the content on the page or screen (i.e. composition of the action), or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content").

As per claim 5, the rejection of claim 1 is incorporated, and further De Boor discloses:

- **representing system states** in terms of n-dimensional data cubes (col. 23:46-47, "determine the initial state of a form in a page", and one can store system states well known formats such as in data cubes or n-dimensional arrays),

- **providing an open interface by making the state information readable and writeable for other programming and database systems** (col. 23:42-47, "There are a number of extensions of HTML in the present invention that allow pages to be designed using a standard HTML editor, using arguments passed (through an open interface) by C code to complete form entry fields, or specifying data to be fetched on the fly from the device to determine the initial state of a form in a page"),

- **making data structures and functionalities of other programming and database systems accessible using executable instructions** (col. 23:42-47, "There are a number of extensions of HTML in the present invention that allow pages to be designed using a standard HTML editor, using arguments passed (using executable instructions) by C code to complete form entry fields, or specifying data to be fetched on the fly from the device to determine the initial state of a form in a page").

As per claim 6, the rejection of claim 1 is incorporated, and further De Boor discloses **modules stored in the memory of the data processing system that define a process for each element, where the modules are valid with respect to a specific DTD, which is also stored in a memory of the data processing system** (col. 3:59-66, "A markup language (i.e. XML) is a computer programming language that allows the content of a page or a screen display (i.e. local behavior and process) to be defined by



the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen", and validating modules with respect DTDs is a well known practice used with XML).

As per claim 7, the rejection of any one of the preceding claims is incorporated, and further De Boor discloses a **system for use with the method according to one of the preceding claims**, (col. 59:35-68:66, "The markup language based man-machine interface", as disclosed in the claims), **comprising:**

- **a server providing services to at least one client by executing at least parts of a XML-document according to a XML-robot specification sent from the client to the server or a server providing services to at least one client by sending a XML-robot specification and a XML-document to the client, such that said service is provided by executing of at least part of the sent document on the client according to the sent XML-robot specification** (col. 9:49-51, "providing a wireless communication device with an MMI (i.e. browser) that is based on a markup language (i.e. XML). A markup language is a computer programming language that allows the content of a page or a screen display to be defined by the inclusion of predefined symbols in the content itself indicating the logical components of the content, instructions for the layout of the content on the page or screen, or other data which can be interpreted by some automatic system responsible for displaying, manipulating or modifying the content", and (below fig 14 and multi part forms) col. 30:14-22, "the data

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from each form (i.e. executable xml document) to be transmitted to the server as part of the URL that fetches the next form (i.e. executable xml document). The server then takes the data passed in the URL and returns a page that must be generated on-the-fly with the passed-in data from the previous forms included as "hidden" type input elements in the form in the returned page").

As per claim 8-10, this is an apparatus version of the claimed method discussed above, in claim 7, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claim 11, this is an apparatus version of the claimed method discussed above, in claim 7, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claim 12, this is another method version of the claimed method discussed above, in claims 3 and 5, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 7:36-23:47.

As per claim 13, this is a computer readable medium/product version of the claimed method discussed above, in claims 3 and 5, wherein all claimed limitations have also been addressed and/or cited as set forth above. Additionally, such a product is deemed to be inherent in the system, otherwise, it would be inoperative.

As per claim 14, this is a computer readable medium/product version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. Additionally, such a product is deemed to be inherent in the system, otherwise, it would be inoperative.

As per claim 15, this is a system version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 16, this is a system version of the claimed method discussed above, in claim 2, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:58-66.

As per claim 17, this is a system version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 18, this is a system version of the claimed method discussed above, in claim 7, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 9:49-51 and col. 30:14-22.

As per claims 19 and 20, this is another method version of the claimed method discussed above, in claim 6, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:59-66.

As per claim 21, this is another method version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see De Boor, col. 3:58-67, col. 9:45-51 and col. 62:9-10.

### ***Response to Arguments***

9. Applicants arguments have been considered but they are not persuasive.

*In the remarks, the applicant has argued substantially that:*

- 1) The Examiner incorrectly states that claim 7 is dependent upon claim 1, at p. 11:9-10 and 11:20-21.

*Examiner's response:*

- 1) The preamble of claim 7 states: "a system for use with the method according to one of the preceding claims". This language indicates that claim 7 is dependant on any one of the previous claims, including claim 1.

*In the remarks, the applicant has argued substantially that:*

2) DeBoor does not disclose a method including at least storing intermediate states of the execution process in an XML document of a memory of the data processing system by dynamically creating and redefining attributes of elements and that the intermediate states stored applicant's invention are different from the intermediate states stored by DeBoor, at p. 12:15-13:2.

*Examiner's response:*

2) DeBoor does disclose storing intermediate states of the execution process in an XML document of a memory of the data processing system by dynamically creating and redefining attributes of elements, at col. 62:9-10.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the differences between the intermediate states stored by applicant's invention and the intermediate states stored by DeBoor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

*In the remarks, the applicant has argued substantially that:*

3) DeBoor does not disclose sending an XML document that is executed according to an XML robot specification, at p. 13:25-26.

*Examiner's response:*

3) The examiner disagrees with applicant's characterization of the applied art.

DeBoor does disclose sending an XML document that is executed according to an XML robot specification, at col. 9:39-30-22, "the data from each form (i.e. executable xml document) to be transmitted to the server as part of the URL that fetches the next form (i.e. executable xml document). The server then takes the data passed in the URL and returns a page that must be generated on-the-fly with the passed-in data from the previous forms included as "hidden" type input elements in the form in the returned page".

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (571) 272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**